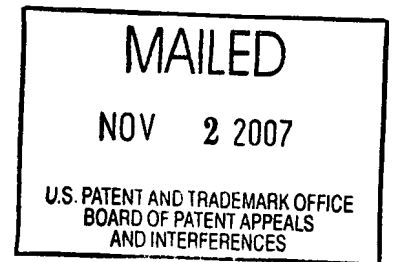


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte: SU-SYIN WU, NANCY CHU
AND SZU-MIN LIN

Application No. 09/746,990

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on October 9, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

EXAMINER'S ANSWER

New Grounds of Rejection

On May 18, 2007, an Examiner's Answer was mailed. The Examiner's Answer included a new ground of rejection, where Claims 8-10 were rejected under 35 U.S.C §103 (a) over Markham or Sackier et al.. A review of the applications reveals claim 10 was never discussed in the Final Rejection mailed January 5, 2006.

When a new ground of rejection is introduced in the Examiner's Answer, the Examiner is required to obtain approval of the Technology Center Director or his/her designee. Further, any

Application No. 09/746,990

new ground of rejection is required to be prominently identified, eg., a separate heading with all capitalized letters. See MPEP § 1207.02(A)(6)(d).

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed May 18, 2007, and mail a Supplemental Examiner's Answer with the approval of the Technology Center Director or designee.

English Translation

The Examiner's Answer mailed May 18, 2007, includes a rejection for claims 16, 17, 27 and 28, under 35 U.S.C. 103(a). The reference relied upon for the rejection of the claims on appeal include a foreign reference (Schad, WO 96/30058). No full length English translation of the above reference has been provided.

The Examiner must provide a complete English translation of any foreign reference relied upon in the rejection of the claims on appeal. Further, a copy of the English translation should be mailed to appellant and forwarded for scanning into IFW.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

1) issue and mail a revised Examiner's Answer, clarifying and properly identifying any new grounds of rejection;

Application No. 09/746,990

- 2) provide a full English translation of the Schad reference; and
- 3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: /PATRICK J. NOLAN/
PATRICK J. NOLAN
Deputy Chief Appeals Administrator
(571) 272-9797

PJN/tsj

cc: PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003